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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,106	08/20/2001	Wai C. Wong	45990-ZAA/JPW/ADM	7129

7590

03/14/2002

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EXAMINER

BALASUBRAMANIAN, VENKATARAMAN

ART UNIT PAPER NUMBER

1624

DATE MAILED: 03/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



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HM12/1107

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BALASUBRAMANIAN, V

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Resteet
3/14/02
11/07/01

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Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/933,106

Applicant(s)
WONG ET AL.

Examiner
Venkataraman Balasubramanian

Art Unit
1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 20, 2001
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 4, 7, 8, 10-14, 21, 22, 24, and 25 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1, 3, 4, 7, 8, 10-14, 21, 22, 24, and 25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

DETAILED ACTION

Applicants' preliminary amendment, which included cancellation of claims 2, 5-6, 9,15-20, 23, 26 and amendment to claims 1, 3, 4, 10-12,14, 21 and 24, filed on 8/20/2001, is made of record.

Claims 1, 3-4, 7-8, 10-14, 21-22 and 24-25 are now pending.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 3-4, 8, 21-22, 24-25 drawn to compounds wherein X= CR7, Y= CR3R5 or CO and $m+n = 2$ or 3, composition and method of use, classified in class 548, subclass 331.5, class 514, subclass 398.
- II. Claims 1, 3-4, 7, 10-12, 14, 21-22, 24-25 drawn to compounds wherein X= CR7, Y= NR6 and $m+n = 2$ or 3, composition and method of use classified in class 546, subclasses 132, 141,143, class 548, subclass 467, class 514, subclasses 307, 398.
- III. Claims 1, 3-4, 21-22, 24-25 drawn to compounds wherein X= CR7, Y= O and $m+n = 2$ or 3, composition and method of use classified in class 549, subclasses 398 and 400, class 514, subclasses 100 and 398.
- IV. Claims 1, 3-4, 21-22, 24-25, drawn to compounds wherein X= CR7, Y= S and $m+n = 2$ or 3, composition and method of use classified in class 549, subclasses 32, 33 and 49, class 514, subclasses 96 and 398.

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- V. Claims 1, 3-4, 8, 13, 21-22, 24-25, drawn to compounds wherein $X = N$ or $N-O$, $Y = NR_6$ and $m+n = 2$ or 3 , composition and method of use classified in class 546, subclasses 113 and 122, class 514, subclasses 300 and 398.
- VI. Claims 1, 3-4, 8, 21-22, 24-25, drawn to compounds wherein $X = N$ or $N-O$, $Y = O$ and $m+n = 2$ or 3 , composition and method of use classified in class 546, subclass 115 and class 514, subclass 398.
- VII. Claims 1, 3-4, 8, 21-22, 24-25, drawn to compounds wherein $X = N$ or $N-O$, $Y = S$ and $m+n = 2$ or 3 , composition and method of use classified in class 546, subclass 114 and class 514, subclass 398.

The inventions are distinct, each from the other because of the following reasons:

The inventions of the Group I-VII are independent and distinct from each other because they are directed to structurally dissimilar compounds that lack common structural core namely bicyclobenzene such as tetrahydroindane, hexahydronaphthalene, tetrahydroisoindole, hexahydroisoquinoline, tetrahydrobezofuran, hexahydrobenzopyran, tetrahydrothienylbenzene and hexahydrothiobenzofuran versus bicyclopiperidines such as tetrahydropyrrolidinopyridine, hexahydronaphthridine, tetrahydrofuranopyridine, hexahydropyranopyridine, tetrahydrothienopyridine, and hexahydrothiopyranopyridine. Consequently, the groups have different classifications and require separate prior art searches. They can be made and used independently. Art which may render obvious or anticipate one of the groups would not necessarily do the same for the other group. Each can support a patent as the compounds of each group are capable of being utilized alone not in combination with other members listed in the Markush group.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.

Due distinct nature of each invention, the restriction is set forth in writing.

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (703) 305-1674. The examiner can normally be reached on Monday through Thursday from 8.30 AM to 5.00 PM.

The fax phone number for the organization where this application or proceeding is assigned (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

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V. Balasubramanian
Venkataraman Balasubramanian

11/07/2001